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09/993,486	11/27/2001	Shinichi Watanabe	P20705	8162

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EXAMINER	
KOROBOV, VITALI A	

ART UNIT	PAPER NUMBER
2155	

NOTIFICATION DATE	DELIVERY MODE
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No.	Applicant(s)	
	09/993,486	WATANABE ET AL.	
	Examiner	Art Unit	
	Vitali Korobov	2155	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *04 April 2007*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *12-18* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *12-18* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

RESPONSE TO AMENDMENT

1. This Office Action is in response to an amendment filed on 04/04/2007. Claims 12-18 are currently pending and have been examined in this Office Action.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).4.

3. Claims 12 and 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over the U. S. Patent 6,944,273 to Huna, hereinafter Huna.

Regarding claim 12, Huna teaches a server apparatus (Fig. 4, the message server 402) connected to a transmitting IP apparatus, the transmitting IP apparatus (Fig. 5, IP apparatus 504) transmitting an e-mail (Fig. 5, box 506) to a receiving IP apparatus

(Fig. 5, fax 524, PC 532, etc.) via the server apparatus (Fig. 4, servers 402 and 404), the server apparatus comprising: a memory configured to store an IP address of to the receiving IP apparatus in association with a telephone number of the receiving IP apparatus (Col. 15, lines 19-25 and lines 51-55), the IP address of the receiving IP apparatus being distinct from an e-mail address (Fig. 7, "To:" field, indicating Richard's telephone number, which is distinct from Richard's IP Address); a receiver configured to receive the e-mail from the transmitting IP apparatus (Col. 16, lines 30-35. User 502 sends message 508 in e-mail format, and IP apparatuses of Joe, Jim and Julie receive it), the e-mail including the telephone number of the receiving IP apparatus (Fig. 7, "To:" field, indicating Richard's telephone number); an analyzer configured to obtain, from the received e-mail, the telephone number of the receiving IP apparatus, and to obtain, from the memory, the IP address of the receiving IP apparatus associated with the telephone number of the receiving IP apparatus (Col. 15, lines 54-60).

Huna does not explicitly teach the implementation of his invention over a data-centric VoIP telephone network.

"Official Notice" is taken that the concept of implementing telephony over data-centric network is old and the advantages of such implementation are well known in the art.

Therefore, it would have been obvious to one of ordinary skills in the art at the time the invention was made to implement the invention of Huna over a digital data-centric telephone network (VoIP) rather than over POTS. One of ordinary skills in the art would be motivated to do so in order to avoid dealing with numerous issues associated

with interfacing of analog and digital network, replace these two networks with one - data-centric, and thereby make the environment over which the invention is implemented more simple and homogeneous. Modified in this manner Huna is hereinafter referred to as modified Huna.

Modified Huna teaches the receiving IP apparatus of the IP address, being the same as the receiving IP apparatus of the telephone number (Col. 15, lines 50- 60); and a transmitter configured to transmit the received e-mail to the receiving IP apparatus, based on the IP address of the receiving IP apparatus (Col. 15, lines 50- 60).

Regarding claim 15, modified Huna teaches the server apparatus according to claim 12, wherein a header of the e-mail from the transmitting IP apparatus includes the telephone number of the receiving IP apparatus (Fig. 7, "To:" field, indicating Richard's telephone number, which is distinct from Richard's IP Address).

Claim 16 is rejected in view of the above rejection of claim 12. Claim 16 is essentially the same as claim 12, except that it sets forth the invention as a system rather than a server apparatus, as does claim 12.

Claim 17 is rejected in view of the above rejection of claim 12. Claim 17 is essentially the same as claim 12, except that it sets forth the invention as a method rather than a server apparatus, as does claim 12.

4. Claims 13 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over modified Huna in view of the U.S. Patent 6,748,057 to Ranalli et al., hereinafter Ranalli.

Regarding claim 13, modified Huna teaches the server apparatus according to claim 12.

Modified Huna does not explicitly teach the server apparatus wherein the transmitter transmits an error message to the transmitting IP apparatus when the memory does not store the IP address of the receiving IP apparatus in association with the telephone number of the receiving IP apparatus.

However, Ranalli in analogous art, related to directory service for enabling communications over a data network such as the Internet, and more particularly to the use of a unique identifier (for example, a telephone number) with this directory as a means for acquiring the associated data network address information for an intended recipient of a communication, teaches industry standard mail transmission protocol, and transmission of an error message to the transmitting IP apparatus when the memory does not store the IP address of the receiving IP apparatus in association with the telephone number of the receiving IP apparatus. (See Ranalli, col. 5, lines 9-12, where Ranalli teaches the use of SMTP protocol as one possible mode of implementation. The industry standard implementation of SMTP (according to RFC 821, August 13, 1982) provides for error notification if the recipient is not registered (Reply Code 550)).

Therefore, it would have been obvious to one having ordinary skills in the art at the time the invention was made to incorporate the teachings of Ranalli regarding implementation of industry standard SMTP protocol for e-mail transmission into the teachings of modified Huna to simplify transfer of electronic mail and to implement many other convenient features SMTP provides.

Regarding claim 18, modified Huna/Ranalli combination teaches the server apparatus according to claim 12, wherein the transmitter transmits the received e-mail to the receiving IP apparatus, based on the IP address of the receiving IP apparatus, in accordance with a SMTP protocol (See Ranalli, col. 5, lines 9-12, where Ranalli teaches the use of SMTP protocol as one possible mode of implementation, and col. 5, lines 50-55, where Ranalli teaches conversion of an e-mail address in a telephone number format into the IP address of the receiving IP apparatus).

5. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over modified Huna in view of the U.S. Patent 6,735,617 to Goodman (hereinafter Goodman).

Regarding claim 14, modified Huna teaches the server apparatus according to claim 12, but fails to explicitly teach such server being connected to a H.323 gatekeeper, the H.323 gatekeeper storing the IP address of the receiving IP apparatus in association with the telephone number of the receiving IP apparatus, the analyzer being configured to determine whether the memory stores the IP address of to the receiving IP apparatus, and when it is determined that the memory does not store the IP address of the receiving IP apparatus, the transmitter accesses the H.323 gatekeeper to obtain the IP address of the receiving IP apparatus.

However, Goodman in analogous art, related to transmission of e-mail, i.e. facsimile copies of documents over H.323 network, teaches a server that is being connected to a H.323 gatekeeper, the H.323 gatekeeper storing the IP address of the receiving IP apparatus in association with the telephone number of the receiving IP

apparatus (Goodman, Fig. 10, sender's mail server 950, and the outbound H.323 gateway 965. See also col. 4, lines 6-7, where Goodman teaches an H.323 gatekeeper's function of finding an IP address for a gateway associated with a telephone number), the analyzer being configured to determine whether the memory stores the IP address of the receiving IP apparatus (See col. 4, lines 6-7, where Goodman teaches an H.323 gatekeeper's function of finding an IP address for a gateway associated with a telephone number), and when it is determined that the memory does not store the IP address of the receiving IP apparatus, the transmitter accesses the H.323 gatekeeper to obtain the IP address of the receiving IP apparatus (See col. 4, lines 65-67, where Goodman teaches that the "IP address – telephone number" look-up table may be maintained at the facsimile mail server or at the H.323 Gatekeeper).

Therefore, it would have been obvious to one having ordinary skills in the art at the time the invention was made to combine the alternative locations for a look-up table taught by Goodman with the teachings of modified Huna in order to take advantage of special records designating which IP addresses are mail servers and make cross-service connectivity in telecommunications network even more seamless and efficient (See col. 3, lines 62-67 and col. 4, lines 1-8 of Goodman).

6. **Examiner's note:** Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

Response to Arguments

7. Applicant's arguments filed 04/04/2007 have been fully considered but they are not persuasive.

The Applicants argue – "*HUNA does not disclose that the message server 402 (514) obtains, from a received e-mail, the telephone number of a receiving IP apparatus, and obtains, from a memory, the IP address of the receiving IP apparatus associated with the telephone number of the receiving IP apparatus, the receiving IP apparatus of the IP address being the same as the receiving IP apparatus of the telephone number.*"

The Examiner respectfully disagrees. Fig. 5 shows addressing of a recipient via an e-mail address comprising a telephone number of the recipient. In 15:54-60 teaches that that based on this number the message is routed to the POP of corresponding telephone number. In a telephone-centric network, the only IP address a telephone number has is the address of the associated POP, and that is where the message is routed. In other words, in a telephone-centric network, all subscribers of the network, connected to a given POP, have the same IP address - that of an associated POP. Therefore, Huna does disclose that the message server 402 (514) obtains, from a received e-mail, the telephone number of a receiving IP apparatus, and obtains, from a memory, the IP address of the receiving IP apparatus associated with the telephone number of the receiving IP apparatus, the receiving IP apparatus of the IP address being the same as the receiving IP apparatus of the telephone number.

The Applicants argue – *"In neither scenario does HUNA teach that the receiving IP apparatus of the IP address (i.e., the local POP 408 (516)) is the same as the receiving IP apparatus of the telephone number (i.e., the receiving device 520, 524 or 528). Additionally, while HUNA discloses storage of an e-mail address, HUNA does not disclose that the server 402 (514) stores an IP address of a receiving IP apparatus. In this regard, the claimed memory defines the IP address of the receiving IP apparatus as being distinct from an e-mail address. Col. 15, lines 19-25 does not mention storage of an IP address, and lines 51-52 disclose routing of the message to the IP address of the receiving IP apparatus but not storage of the IP address at the message server 402 or routing to an IP address based on any storage of the IP address at the message server 402."*

The Examiner respectfully disagrees. In 15:54-60 teaches that that based on this number the message is routed to the POP of corresponding telephone number. In a telephone-centric network, the only IP address a telephone number has is the address of the associated POP, and that is where the message is routed. In other words, in a telephone-centric network, all subscribers of the network, connected to a given POP, have the same IP address - that of an associated POP. Huna would not be able to transmit a message to an IP address of the recipient unless that address was stored in memory. Fig. 5 of Huna shows that an IP address of the receiving IP apparatus indeed is being distinct from an e-mail address.

The Applicants argue – *"Additionally, the Office Action incorrectly asserts that the claimed analyzer and transmitter are disclosed at column 15, lines 50-60. However, this*

portion of HUNA relates to the routing of messages either directly to a receiving device 532 or to a local POP 408 (516)."

The Examiner respectfully disagrees. The message server 402 of Huna performs the same function as claimed by the Applicants and therefore reads on the analyzer of claim 12 of the instant application.

The Applicants argue – *"A telephone number is not utilized in such routing for devices connected to the data-centric network 406. On the other hand, for receiving devices 520, 524, 528 connected to the telephony-centric network, a message router embeds a telephone number of a receiving device into the message, and routes the message to the IP address of the local POP 408 (516) corresponding to the embedded telephone number."*

The Examiner respectfully disagrees. The telephone number is utilized to determine the POP of the recipient.

The Applicants argue – *"Furthermore, upon the local POP 408 (516) receiving the message, the message for receiving devices connected to the telephony-centric network is transmitted via the telephony-centric network by the local switch 454. Thus, a transmitter in HUNA is not configured to transmit the received e-mail to the receiving IP address, based on an IP address of the receiving IP apparatus."*

The Examiner respectfully disagrees. In 15:54-60 teaches that that based on this number the message is routed to the POP of corresponding telephone number. In a telephone-centric network, the only IP address a telephone number has is the address of the associated POP, and that is where the message is routed. In other words, in a

telephone-centric network, all subscribers of the network, connected to a given POP, have the same IP address - that of an associated POP.

The Applicants argue – *"The asserted modification of replacing POTS in HUNA with a data-centric network renders the entire purpose of HUNA superfluous and unnecessary."*

The Examiner respectfully disagrees. Huna has an independent utility in all-digital networks, as clearly stated in at least 15:52-54.

The Applicants argue – *"However, RANALLI does not disclose at least the claimed analyzer."* The Applicants further argue - *"Thus, RANALLI does not contain any disclosures regarding a server that includes an analyzer configured to obtain, from the received e-mail, the telephone number of the receiving IP apparatus. Further, RANALLI does not disclose at least a server that includes a transmitter configured to transmits the received e-mail to the receiving IP apparatus, based on the IP address of the receiving IP apparatus."*

The Examiner respectfully submits that Ranalli has not been cited to reject the limitations directed to a server that includes an analyzer and therefore the Applicants' argument is moot.

The Applicants argue – *"Further, RANALLI does not disclose at least a server that includes a transmitter configured to transmits the received e-mail to the receiving IP apparatus, based on the IP address of the receiving IP apparatus."*

The Examiner respectfully submits that Ranalli has not been cited to reject the limitations directed to a server that includes a server that includes a transmitter

configured to transmits the received e-mail to the receiving IP apparatus, based on the IP address of the receiving IP apparatus, and therefore the Applicants' argument is moot.

The Applicants argue – *"Moreover, the Office Action has not set forth any proper motivation for the proposed combination aside from the unsupported assertion that HUNA and RANALLI are analogous art. In this regard, motivation must constitute some suggestion, incentive or other basis for the proposed combination, not merely the assertion that two patents come from analogous fields."*

The Examiner respectfully submits that the motivation to combine Huna and Ranalli is clearly stated in the part of the Office Action related to rejection of claim 17: "to simplify transfer of electronic mail and to implement many other convenient features SMTP provides." These features of SMTP are well known to anyone of ordinary skills in the art.

The Applicants argue – *"Thus, GOODMAN does not contain any disclosure regarding a telephone number of the VOIP Outbound Gateway 956. Thus, GOODMAN does not disclose a H.323 gatekeeper which stores the IP address of the receiving IP apparatus associated with the telephone number of the receiving IP apparatus, since GOODMAN does not contain any disclosure regarding an IP address of the facsimile machine 975 or a telephone number of the VOIP Outbound Gateway 956."*

The Examiner respectfully disagrees. The IP address of the receiving facsimile machine is the same as the IP address of the associated gateway. The Applicants need to keep in mind that the facsimile machines in Goodman are conventional facsimile

machines, and have the same IP address as the associated gateway. The gateway distinguishes between these machines using their respective telephone numbers.

The Applicants argue – *"Further, an address, for example, 1112223333@faxservername.xxx, is utilized for forwarding a facsimile message to the facsimile machine 975. The address consists of the conventional telephone number of the facsimile machine 975 and a name of the facsimile mail server 950 (col. 6, lines 38-46 and col. 7, line 15). In other words, the address does not include an address of the VOIP Outbound Gateway 956. Thus, GOODMAN does not contain any disclosure regarding a telephone number of the VOIP Outbound Gateway 956."*

The Examiner respectfully disagrees and refers the Applicants to 4:4-19, where Goodman teaches look-up and translation of domain names in the e-mail addresses in the example given by the Applicants, using DNS servers, into IP addresses of the gateways associated with receiving facsimile machines using their respective telephone numbers.

The Applicants argue – *"GOODMAN also does not disclose an analyzer configured to determine whether the memory stores the IP address of the receiving IP apparatus. Further, GOODMAN does not disclose a transmitter which accesses the H.323 gatekeeper to obtain the IP address of the receiving IP apparatus when it is determined that the memory does not store the IP address of the receiving IP apparatus."*

The Examiner respectfully submits that Goodman was cited in relations to limitations of claim 14 directed to utilization of H.323 gateways, not in relation to the

limitations directed to an analyzer or a transmitter. Therefore, the argument above is moot.

The Applicants argue – *"Additionally, Fig. 13 of GOODMAN shows a gatekeeper lookup table which contains zones, gateway addresses, and gateway priority. However, none of these teach an IP address of the receiving IP apparatus associated with the telephone number of the receiving IP apparatus."*

The Examiner respectfully disagrees and refers the Applicants to 4:4-19, where Goodman teaches look-up and translation of domain names in the e-mail addresses in the example given by the Applicants, using DNS servers, into IP addresses of the gateways associated with receiving facsimile machines using their respective telephone numbers. The receiving facsimile machines have the same IP addresses as their respective gateways, as was already pointed out several times above.

The Applicants argue – *"Further, the Office Action has not set forth any proper basis or motivation for the combination of the teachings of GOODMAN and HUNA. The mere assertion, even if true, that GOODMAN and HUNA are in analogous arts, does not in and of itself provide the suggestion required for a proper motivation under 35 U.S.C. § 103."*

The Examiner respectfully disagrees and refers the Applicants to the rejection of claims 14, where the motivation to combine Huna and Goodman is clearly stated after the words "in order to".

Therefore, the Office respectfully maintains the rejection of all pending claims and makes the rejection final.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vitali Korobov whose telephone number is 571-272-7506. The examiner can normally be reached on Mon-Friday 8a.m. - 4:30p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Saleh Najjar can be reached on (571)272-4006. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Vitali Korobov
Examiner
Art Unit 2155

VAK
06/10/2007

SALEH NAJJAR
SUPERVISORY PATENT EXAMINER